

## REMARKS

As a preliminary matter, Applicant thanks the Examiner for the continued allowance of claims 1-2, 10-11, and 14, and for the additional allowance of claims 4 and 6.

As a second preliminary matter, the Specification stands objected to for failing to provide proper antecedent basis for claimed subject matter. Specifically, the Examiner appears to be objecting to the recited terms “pattern alignment” and “fusing” in claim 8. Applicant respectfully traverses this objection. The Specification provides clear and repeated support for this original language from claim 8. Nevertheless, in the interests of expediting prosecution, Applicant has amended claim 8 to avoid the specific words the Examiner appears to find to be unsupported. By this amendment therefore, Applicant submits that the scope of claim 8 has not been narrowed in any way, and has actually been broadened, while still remaining entirely consistent with the exact language disclosed throughout the Specification. Accordingly, reconsideration and withdrawal of this objection are respectfully requested.

Claim 8 itself now stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Specifically, this rejection appears to be essentially identical to the Examiner’s basis for the objection to the Specification discussed above. Applicant therefore traverses this rejection for the same reasons as those discussed above. The original language from claim 8, as cited by the Examiner, is entirely consistent with the Specification, disclosure, and the drawings. These features from claim 8 are described with respect to

several of the embodiments in the Specification, and are not limited to only one embodiment or drawing.

As one example, Applicant respectfully directs the Examiner's attention to page 25, lines 12-24 of the Specification to the present Application where one description of the reference mark 15 for alignment is provided. Applicant submits that this mark is further described with respect to several other embodiments, elsewhere also referred to as a "fiducial mark," and is otherwise described with respect to the sub-TFT substrate processing. Applicant submits that one skilled in the art, with the benefit of the present Application, would fully understand that such marks could also be fused to the substrates.

Nevertheless, as discussed above, claim 8 has been amended in the interests of expediting prosecution, to remove the terms the Examiner finds unclear. As a result, Applicant again submits that claim 8 has been only broadened in its scope by these amendments, but still fully encompasses the more specific features cited in the original claim language. Reconsideration and withdrawal of this rejection are thus respectfully requested.

Claims 3, 5, 7, and 12-13 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner's only basis for this rejection appears to be his broad assertion that the respective subject matter in these dependent claims is only described in the Specification in the description of different embodiments, and that the Examiner does not understand how the teachings in these several

embodiments could be combined in any way. Applicant respectfully traverses this rejection in its entirety.

The Section 112 rejection is deficient for several reasons. First, the Examiner's general, and overly broad, principle that the Specification must describe how to combine each and every disclosed embodiment is contrary to established patent law. Second, the Examiner's assertion that the Specification does not describe how the teachings in the several embodiments may be combined is contrary to the plain language of the Specification. Third, the Examiner's assertion that Applicant did not point out where in the original disclosure such combinations are taught is contrary to the many meritorious arguments presented by Applicant on pages 8 through 12 of Amendment B, filed February 18, 2004, which Amendment is incorporated by reference herein.

The C.C.P.A. long ago rejected the Examiner's broad proposition that the written description requirement requires that the claims must correspond only to specific embodiments described in the Specification. There is a general rule for inventions in predictable arts (typically, those not involving chemical interactions) that an Applicant may be allowed claims that cover more than the specific embodiments shown, if the prior art permits. See In re Newton, 414 F.2d 1400, 1406, 163 USPQ 34, 39 (C.C.P.A. 1969); see also Donner, Patent Prosecution, Practice & Procedure Before the U.S. Patent Office, 3d Ed., pp. 1017-1018 (2003). The written description requirement may still be satisfied even if claims cover more than what is described in the several examples provided in different embodiments in the

Specification. See In re Smythe, 480 F.2d 1376, 178 USPQ 279, 284 (C.C.P.A. 1973). The only standard that the Examiner should apply to the examination of such features is whether one skilled in the art, with the benefit of the present Application, could understand how such potential combinations could occur.

In the present case, however, the Examiner has not applied this required standard. The Examiner has instead only applied the discredited proposition described above.

As such, the Examiner has not established a proper Section 112 rejection. Applicant submits that one skilled in the art will understand the scope of all of the claims of the present invention with the benefit of the present Application. Because the Examiner has never refuted this statement, this Section 112 rejection should be withdrawn.

Furthermore, the Examiner's assertion that the Specification does not describe combinations of features from the several disclosed embodiments is clearly erroneous. Nowhere does the Specification describe only the strict and narrow interpretation the Examiner imposes on the several embodiments of the present Application. In fact, the Specification expressly teaches the opposite of the Examiner's narrow interpretation. The Specification, for example, expressly states (in the portion the Examiner asserts must only describe the fifth embodiment) on page 48, lines 10-12:

As can be understood from FIG. 24, the process for the image sensor 142 is basically the same as that for forming a liquid crystal panel until formation of TFT. Thus, in the [fifth] embodiment, as in the case of the first embodiment, a conductive film, an insulating film and a semiconductor film are formed to constitute TFT of the display region and the image

sensor in the state of the master glass substrate. (Emphasis added).

This portion of the Specification therefore directly contradicts the Examiner's assertion that the Specification does not describe where the fifth embodiment, for example, can be combined with others. This portion of text clearly describes significant commonality between many of the steps in the several embodiments. The Examiner appears to have failed to even consider this language from the Specification.

Applicant submits that the Examiner's entire standard for establishing the outstanding Section 112 rejection is inappropriate. A proper examination of the present claims should not be based upon whether or not the Specification expressly states every detail of how one particular embodiment can be combined with another, but instead should focus only on what one skilled in the art can comprehend. As discussed above, the C.C.P.A. long ago expressly rejected this exact type of misplaced inquiry.

Section 2163.04 of the MPEP reiterates the long-standing Marzocchi principle that a written description as filed is presumed to be adequate, unless or until sufficient evidence to the contrary has been presented by the Examiner to rebut this presumption. To rebut this presumption, the Examiner is required to present by a preponderance of evidence why *a person skilled in the art would not recognize in the Applicant's disclosure* a description of the invention defined by the claims. See In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (C.C.P.A. 1976). Section 2163.04 further expressly places the burden of proof on the Examiner with respect to the written description requirement. In the present case, however,

the Examiner has not even made such an inquiry, nor has the Examiner presented *any* factual evidence how one skilled in the art would not recognize the description of the claims at issue in the present Application.

Given the unambiguous burden placed upon the Examiner, Applicant is at a loss to understand the Examiner's statement on the bottom of page 3 of the outstanding Office Action, that what one skilled in the art would comprehend from Applicant's written disclosure "is not the issue." Both the MPEP and established case law unquestionably state that this inquiry is *exactly* the issue the Examiner is required to determine. Accordingly, for at least these additional reasons, this Section 112 rejection is deficient, and should be withdrawn.

Furthermore, Applicant had even provided a detailed discussion in Amendment B how one skilled in the art would clearly understand the invention in the specific claims at issue from the original disclosure of the Application. Applicant notes that the Examiner has not answered or rebutted a single one of these many meritorious arguments in repeating the same Section 112 rejection, even though the Examiner was required to do so under Section 2163.04(II) of the MPEP. For at least these reasons as well, the Examiner should be required to withdraw the Section 112 rejection.

In fact, the Examiner's only rationale presented in rebuttal to Amendment B is the presentation of a single hypothetical claim involving the features "A, B, and C." This hypothetical discussion by the Examiner therefore, utterly fails to consider any of the *specific* features of the present invention, which are actually recited in the claims at issue, which

specific features the Examiner is required to consider and address. To date, the Examiner has only discussed these claims with respect to their relationship to the different embodiments in the Specification, but never in relation to the actual features and limitations recited in the claims themselves. The Examiner has never stated what particularly claimed feature from any one of the claims would not be clear to one skilled in the art, from the written description of the Application. Therefore, the Examiner has failed to present any evidence why a person skilled in the art would not recognize in the disclosure a description of the specific inventions defined by the several individual claims.

As previously discussed, any reasonable consideration of the claims at issue would demonstrate that these claims are entirely consistent with the written description. As discussed above, the Specification specifically teaches that the processing steps for the fifth embodiment may be the same as those in other embodiments up to formation of the TFT. It is therefore highly significant that the subject matter of claims 5 and 7 in particular is drawn to steps performed *prior to* TFT formation. In other words, the subject matter of claims 5 and 7 recites portions of the process that the Specification expressly teaches can be the same between the fifth and the other embodiments. The Examiner's rejection of these two claims specifically is therefore erroneous, and must be withdrawn. The Examiner has failed to even comment on this exact discussion from Amendment B.

Different from claims 5 and 7, the subject matter of claims 3 and 12-13 is drawn either to what sizes (claim 3) or types (claims 12 and 13) of panels may be formed. In

repeating the rejection of these claims specifically, the Examiner appears to have entirely ignored all of the text on pages 51 and 52 of the present Specification. This portion of text from the Specification clearly describes how at least the teachings in the fifth embodiment can be applied to at least nine different types and sizes of devices. In other words, the Specification here exactly contradicts the Examiner's assertion.

The fifth embodiment is drawn to a process of forming an image sensor on a liquid crystal panel, and that such image sensors may be formed on many different sizes and types of liquid crystal panels. (See page 47, lines 12-16 of the Specification). By limiting the discussion to only hypothetical "embodiments," the Examiner has improperly avoided having to consider the actual claim language itself from the rejected claims. Claims 3 and 12-13 are clearly supported by the written description of the Specification, and the Section 112 rejection to the contrary must be withdrawn.

Lastly, Applicant wishes to point out that the Examiner's discussion of Figs. 23 and 25 of the present Application (page 3 of the outstanding Office Action) further illustrates how the Examiner has improperly substituted his own contradictory interpretation in place of the actual teachings of the Specification. The Examiner inappropriately adds a restriction to Figs. 23 and 25 that these drawings must illustrate only liquid crystal panels formed of the same size within a master substrate. Nowhere, however, does any portion of the written description in the Specification require that the panels in these drawings all be formed of the same size.



Figs. 23 and 25 are not described to be schematic diagrams for substrate sizing, but instead as examples to show how the image sensors 142 and 147 can be placed on liquid crystal panels in general. Nowhere does the Specification even imply that placement of the image sensors can only be performed when the individual panels are all the same size. This description in the fifth embodiment is provided mainly to illustrate the placement of the image sensors, and not to narrowly restrict the formation of the panels themselves, which is described elsewhere in detail throughout the Specification, in the other described embodiments.

Additionally, it is a well-known principle of patent prosecution that, unless specifically taught otherwise, illustrations in the drawings are not presumed to be to scale. In the present case, there is no description in the Specification, or on Figs. 23 and 25, requiring the panels shown to be of “the same size.” The Examiner here has therefore inappropriately imposed his own limitations on the written description that do not exist in the Application. The Examiner’s reinterpretation of the Specification is even more inappropriate in light of the fact that the Specification, in regard to Figs. 23 and 25, only teaches that the liquid crystal panels are formed “having a specified size.” (See page 51, lines 7-8). Elsewhere in the Specification, the “specified sizes” are shown to be large, small, the same, or different within the same master substrate. Applicant therefore again requests that the Examiner please examine the actual language recited in the claims themselves, address the actual arguments presented by Applicant, and not add limitations to the Specification that do not exist.

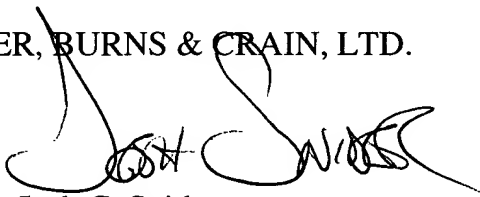
The Specification itself has been amended only to correct for typographical errors, and not in response to any stated rejection or objection by the Examiner. Applicant submits that no new matter has been added by these amendments.

For all of the foregoing reasons, Applicant submits that this Application, including claims 1-8 and 10-14, is condition for allowance, which is respectfully requested. The Examiner is invited to contact the undersigned attorney if an interview would expedite prosecution.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By

A handwritten signature in black ink, appearing to read "Josh C. Snider", is written over the printed name and registration number.

Josh C. Snider

Registration No. 47,954

**Customer No. 24978**

July 29, 2004

300 South Wacker Drive  
Suite 2500

Chicago, Illinois 60606

Tel: (312) 360-0080

Fax: (312) 360-9315

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